

12/04/98



GP 2872

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re application of:

Dickensheets et al.

Serial No. 09/070,699

Filed: April 30, 1998

For: *MINIATURE SCANNING CONFOCAL
MICROSCOPE*

Art Unit: 2872

Examiner: not assigned

TRANSMITTAL

Date: December 3, 1998

"EXPRESS MAIL" MAILING LABEL NUMBER EL048677039US

I hereby certify that this correspondence is being deposited with the U.S. Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10 and is addressed to Box Non-Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231 on December 4, 1998.

Signed:

Evanjin Dasalla

BOX NON-FEE AMENDMENT

Assistant Commissioner for Patents
Washington, D.C. 20231

Sir:

Enclosed for filing in the referenced case are the following:

1. Amendment;
2. Interference - Initial Memorandum, PTO Form 850;
3. Request for an Interference with Two Applications under 37 CFR 1.604;
4. Return Receipt postcard.

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GROUP 2100

The Commissioner is hereby authorized to charge any fees which may be due in connection with this communication, including any extension fees, to our Deposit Account No. 06-1300 (Order No. A-62591-3/AJT). A copy of this sheet is provided for such purpose.

Respectfully submitted,

Aldo J. Test, Reg. No. 18,048

FLEHR HOHBACH TEST ALBRITTON & HERBERT LLP
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(650) 494-8700

INTERFERENCE-INITIAL MEMORANDUM

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:
This interference involves 3 Parties

EXAMINERS INSTRUCTIONS - This form need not be typewritten. Complete the items below and forward to the Group Clerk with all file including those benefit of which has been accorded. The parties need not be listed in any specific order. Use a separate form of each count.

(See MPEP 2309.02)

BOARD OF PATENT APPEALS AND INTERFERENCES: An interference is found to exist between the following cases:

1. PARTY WILDE ET AL.	APPLICATION NO. 08/832,422	FILING DATE MARCH 24, 1997	PATENT NO., IF ANY	ISSUE DATE, IF ANY
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If application has been patented, have maintenance fees been paid? ☐ Yes ☐ No ☐ Maintenance Fees not due yet

The claims of this party which correspond to this count are: 146-184. The claims of this party which do not correspond to this count are (none).

*Accorded the benefit of:

COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	60/022,775	JULY 30, 1996		
U.S.	60/023,476	AUGUST 06, 1996		
U.S.	60/025,801	AUGUST 27, 1996		

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The claim(s) of this party which does (do) not correspond to this count is (are):

GROUP 2100

PATENTED OR PATENTABLE PENDING CLAIMS**UNPATENTABLE PENDING CLAIMS**

2. PARTY MAYNARD	APPLICATION NO. 08/695,717	FILING DATE AUGUST 12, 1996	PATENT NO., IF ANY	ISSUE DATE, IF ANY
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If application has been patented, have maintenance fees been paid? ☐ Yes ☐ No ☐ Maintenance Fees not due yet

The claims of this party which correspond to this count are: 1-61 The claims of this party which do not correspond to this count are (none).

*Accorded the benefit of:

COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
NONE				

The claim(s) of this party which does (do) not correspond to this count is (are):

PATENTED OR PATENTABLE PENDING CLAIMS**UNPATENTABLE PENDING CLAIMS**

3. PARTY Dickensheets et al.	APPLICATION NO. 09/070,699	FILING DATE April 30, 1998	PATENT NO., IF ANY	ISSUE DATE, IF ANY
If application has been patented, have maintenance fees been paid? <input type="checkbox"/> Yes <input type="checkbox"/> No <input type="checkbox"/> Maintenance Fees not due yet				
The claims of this party which correspond to this count are: <u>27-43</u> The claims of this party which <u>do not</u> correspond to this count are <u>(none)</u> .				
*Accorded the benefit of:				
COUNTRY	APPLICATION NO.	FILING DATE	PATENT NO., IF ANY	ISSUE DATE, IF ANY
U.S.	08/575,687	December 19, 1995		
U.S.	60/006,303	November 11, 1995		
U.S.	08/797,931	February 12, 1997		
The claim(s) of this party which does (do) <u>not</u> correspond to this count is (are):				
PATENTED OR PATENTABLE PENDING CLAIMS			UNPATENTABLE PENDING CLAIMS	
<p align="center">Instructions</p> <p>1. For every patent involved in the interference, check if the maintenance fees have been paid by using the Patent Number with PALM screen 2970. If fees are due and they have not been paid, the Interference cannot be declared since it would involved an expired patent (35 U.S.C. §135(a), 37 C.F.R. §1.606)</p> <p>2. For each party, identify the patentable (or patented) and unpatentable (pending) claims which correspond to the count (37 C.F.R. §1.60(f), (n); §1.609(b)(2)).</p> <p>3. For each party, identify the patentable (or patented) and unpatentable (pending) claims which do not correspond to the count of (37 C.F.R. §1.609(b)(3)).</p> <p>4. <u>Forward all files including those the benefit of which is being accorded.</u></p> <p>5. <u>Keep a copy of the Interference Initial Memorandum and any attachments for your records.</u></p> <p align="right">RECEIVED DEC 09 1998 GROUP 2100</p> <p align="center">All Information Requested Below Must Be Attached On (a) Separate Typewritten Sheet(s).</p> <p>6. On a separate sheet, set forth a single proposed interference count. If any claim or any party is exactly the same word for word as this count, please indicate the party, application or patent number, and the claim number.</p> <p>7. For each claim designated as corresponding to the count, provide an explanation of why each claim defines the same patentable invention as the count (37 C.F.R. §1.609(b)(2)).</p> <p>8. For each claim designated as not corresponding to the count, provide an explanation of why each claim defines a separate patentable invention from the count (37 C.F.R. §1.609(b)(3)).</p> <p>9. For each additional count, if any, repeat steps 2-6 and, additionally, provide an explanation why each count represents a separate patentable invention from every other count (37 C.F.R. §1.609(b)(1)).</p>				
DATE	PRIMARY EXAMINER (signature)	TELEPHONE NO.:	ART UNIT	
DATE	GROUP DIRECTOR SIGNATURE (if required)			

* The application number and filing date of each application the benefit of which is intended to be accorded must be listed. It is not sufficient to merely list the earliest.

COUNT 1

The party Maynard's claims _____

or

The party Wilde et al.'s claims 146, 169, and 184

or

The party Dickensheets et al.'s claims 27 and 43.

The count includes all of the independent claims among the party Maynard's claims 1-61, all of the independent claims in the party Wilde et al.'s claims 146-184, and all of the independent claims in the party Dickensheets et al.'s claims 23-47. The party Maynard's dependent claims, the party Wilde et al.'s dependent claims, and the party Dickensheets et al.'s dependent claims are drawn to subject matter that would have been obvious to one having ordinary skill in the art from the subject matter of the respective parent independent claims.



IN THE UNITED STATES PATENT & TRADEMARK OFFICE

5/ Set
Request
Interference
Leurs
12-15-98

IN RE APPLICATION OF :

DICKENSHEETS ET AL.

: GROUP ART UNIT: 2872

SERIAL NO: 09/070,699

: EXAMINER: Not assigned

FILED: April 30, 1998:

FOR: Miniature Scanning Confocal
Microscope

: December 4, 1998

"EXPRESS MAIL" MAILING LABEL NUMBER ELO48677039US

I hereby certify that this correspondence is being deposited with the U.S. Postal Service "EXPRESS MAIL POST OFFICE TO ADDRESSEE" service under 37 CFR 1.10 and is addressed to Box Non-Fee Amendment, Assistant Commissioner for Patents, Washington, D.C. 20231 on December 4, 1998.

Signed: 

Evanjin Dasalla

37 CFR 1.604 REQUEST FOR AN
INTERFERENCE WITH TWO APPLICATIONS

ASSISTANT COMMISSIONER FOR PATENTS
WASHINGTON, D.C. 20231

SIR:

I. 37 CFR 1.604(a)(1)

Applicants propose the following count, which is in the format approved by the Commissioner in Orikasa v. Oonishi, 10 USPQ2d 1999, 2003 (Comm'r 1990), and Davis v. Uke, 27 USPQ2d 1180, 1188 (Comm'r 1993):

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Claims (all of the independent claims) of the party Maynard's application serial

No. 08/695,717¹

5,872,880 N30 385/88

or

claims 146, 169, and 182 of the party Wilde et al.'s application serial No. 08/823,422²

or

claims 27 and 43 of the party Dickensheets et al. application serial No. 09/070,699.

Nabv/
369/112

It should be noted that, pursuant to the Commissioner's opinion in Orikasa, it is appropriate to use a count of this type where the recited claims are in different statutory classes so long as the subject matter recited in the various claims is not patentably distinct.

An extra copy of the proposed count is submitted herewith for the examiner's use in filling out the form PTO-850. In addition, as explained in Section V of this request, a proposed form PTO-850 is submitted herewith for the examiner's convenience.

II. 37 CFR 1.604(a)(2)

The other applications are application serial No. 08/695,717 filed August 12, 1996 naming Ronald S. Maynard as inventor and application serial No. 08/823,422 filed March 24, 1997 naming Jeffrey P. Wilde, Joseph E. Davis, Jerry E. Hurst, John F. Heanue, Kurt E. Petersen, Terry McDaniel, Jeff Drazan, and Joseph Drake (hereinafter referred to as "Wilde et

¹A copy of WO98/07060 is submitted herewith as Exhibit 1. That published application claims the benefit of the filing date of application serial No. 08/695,717.

²Applicants have access to the file of the Wilde et al. application, so they know the numbers of the claims in that application. In addition, they are aware that Wilde et al. are also requesting this interference.

al.”) as inventors. The assignee of the Maynard application, if any, is unknown. If that application is now abandoned, this request is directed to any continuation of that application now pending. The assignee of the Wilde et al. application is Seagate Technology, Inc.

All 61 claims in Maynard’s application as published in WO98/07060 correspond to the proposed count. Indeed, the proposed count includes all the independent claims in that application. Claims 146-182 in the Wilde et al. application correspond to the count. Indeed, the proposed count includes all of the independent claims in that group.

Claims 27-43 of the Dickensheets et al. application presented in the 37 CFR 1.604(a)(1) amendment submitted herewith correspond to the proposed count. Indeed, the proposed count includes all of the independent claims in that group of claims.

III. 37 CFR 1.604(a)(3)

The interference should be declared because, as shown by the table below, the parties are claiming the same invention. The claims of the respective parties that are identical to or substantially identical to each other are as follows:

<u>Wilde et al. Application</u>	Maynard’s Published PCT <u>Application WO/07060</u>	Dickensheets et al. <u>Application</u>
146	1	
147	2	
148	3	
149	4	
150	5	
151	6	

152	7	
153	8	
154	10	
155	11	
156	12	
157	13	
158	14	
159	15	
160	16	
161	17	
162	18	
163	19	
164	20	
165	21	
166	22	
167	23	
168	24	
169	42	27
170	43	28
171	44	29
172	45	30
	46	31
	47	32
173	48	33
174	49	34
175	52	35

176	53	36
177	54	37
178	55	38
	58	39
179	59	40
180	60	41
181	61	42
182		43

The only substantive differences between Wilde et al.'s claims and Maynard's claims listed above are (1) that, in line 2 of Maynard's claim 1, "a substrate defining one or more aligned cavities" has been changed to --a substrate defining at least one cavity-- in Wilde et al.'s claim 146; (2) that, in line 5 of Maynard's claim 1, "an upper cavity provided in a portion of said substrate..." has been changed to --an upper cavity provided on a portion of said substrate...-- in Wilde et al.'s claim 146; (3) that in line 3-5 of Maynard's claim 6 and 14, "light detectors...plasma light sources" has been changed to--or light detectors--in Wilde et al.'s claims 151 and 158; (4) that, in lines 5-9 of Maynard's claim 12, "a suspended bridge means...; a cantilever hinge means..." has been deleted from Wilde et al.'s claim 156; (5) that, in lines 1-4 of Maynard's claim 15, "further comprising: a cantilever hinge means...and" has been deleted from Wilde et al.'s claim 159; (6) that, in line 9 and 10 of Maynard's claim 15, "in a generally upward direction" has been deleted from Wilde et al.'s claim 159; (7) that, in line 3 of Maynard's claim 17, "one or more sets" has been changed to --at least one set--in Wilde et al.'s claim 161; (8) that, in lines 8-10 of Maynard's claim 17, "by a cantilever hinge

means such that said beam steering means is capable of deflecting downward into said upper cavity" has been deleted from Wilde et al.'s claim 161; (9) that, in line 3 of Maynard's claim 19, "into one or more sets" has been changed to --in at least one set--in Wilde et al.'s claim 163; (10) that, in lines 4 and 6 of Maynard's claim 19, "cantilever" has been deleted in Wilde et al.'s claim 163; (11) that, in lines 8-10 of Maynard's claim 19, "by a cantilever means such that said beam steering is capable of deflecting downward into said upper cavity" has been deleted from Wilde et al.'s claim 163; (12) that, in line 3 of Maynard's claims 20, "cantilever" has been deleted in Wilde et al.'s claim 164; (13) that, in line 3 of Maynard's claim 21, "cantilever" has been deleted in Wilde et al.'s claim 165; (14) that, in lines 4 and 5 of Maynard's claim 21, "one or more independent axes" has been changed to--at least one independent axis--in Wilde et al.'s claim 165; and (15) that, in lines 8-10 of Maynard's claim 21, "thereby forming a cantilever hinge means such that said beam steering means is capable of deflecting downward into said upper cavity" has been deleted in Wilde et al.'s claim 165; (16) that, in line 3 of Maynard's claim 22, "cantilever" has been deleted from Wilde et al.'s claim 166; (17) that the substance of Maynard's claim 46 has been added to his claim 42 in the Wilde et al.'s claim 169; (18) that, in lines 1-3 of Maynard's claim 45, "is a laser printer engine...electrode" has been changed to--includes a laser printer engine--in Wilde et al.'s claim 172; (19) that, in lines 1-3 of Maynard's claim 48, "is a laser plotter... electrode" has been changed to--includes a laser plotter--in Wilde et al.'s claim 173; (20) that, in lines 1-3 of Maynard's claim 49, "is a laser marking tool...electrode" has been changed to --includes a laser marking tool--in Wilde et al.'s claim 174; (21) that, in lines 1-3 of Maynard's claim 52, "is an optical switch...electrode" has been changed to--includes an optical switch--in Wilde et al.'s claim

175; and (22) that, in line 1 of Maynard's claim 53, "further comprising" has been changed to--wherein said control means comprises-- in Wilde et al.'s claim 176. Wilde et al.'s claim 169, 173, 174, 175, and 176 differ from the Dickensheets et al claims 27, 33, 34, and 35 in the same respect as they do from Maynard's claims 42, 48, 49, and 52, respectively. Applicants do not consider Maynard's claim 42 to be patentable over the prior art, and they have therefore combined the subject matter in Maynard's claims 42 and 46 in drafting Wilde et al. claim 169.

As shown in Fig. 15 of Wilde et al.'s application, the upper cavity 453 is located on the step 493 in the substrate 444. Thus, the subject matter set forth in Wilde et al.'s claim 146 is directed to the same patentable invention as that set forth in Maynard's claim 1. Likewise, the minor changes in Wilde et al.'s claims 151, 156, 158, 159, 161, 163, 164, 165, 166, 169, 173, 174, 175, and 176 compared to Maynard's claims 6, 12, 14, 15, 17, 19, 20, 21, 22, 42, 45, 48, 49, 52, and 53 are of no patentable significance. Claims 147 to 168 depend directly or indirectly from claim 146 and therefore include the differences noted above with respect to claim 146. Claims 157 and 158 depend from claim 156 and includes the difference noted above with the respect to that claim. Claim 162 depends from claim 161, claim 164 depends from 163, and claim 166 depends from claim 165. Therefore those of Wilde et al.'s claims include the differences noted above with respect to their claims 161, 163, and 165. Claim 171-181 depend from claim 169 and include the changes noted above with respect to that claim.

Wilde et al.'s claim 184 is also identical to Dickensheets et al.'s claim 43.

Thus, it is clear that the parties are claiming the same invention.


IV. REQUEST FOR THE BENEFIT OF THE FILING DATES OF APPLICANTS' PRIORITY APPLICATIONS

Applicants Dickensheets et al. claim priority under 35 USC 119(e) based upon provisional application serial No. 60/0006,303, which was filed on November 11, 1995 and under 35 USC 120 based on application serial No. 08/575,687, which was filed on December 19, 1995, now U.S. Patent No. 5,742,419, and application serial No. 08/797,931, which was filed on February 12, 1977. Applicants Dickensheets et al. are entitled to the benefit of the filing dates of their earlier filed applications for interference purposes if the count reads on at least one adequately disclosed embodiment in the earlier application.³ Assuming that the examiner recommends to the board applicants' proposed count, applicants clearly meet that standard.

V. SUBMISSION OF PROPOSED FORM PTO-850

Submitted herewith for the convenience of the examiner is a proposed form PTO-850.

Respectfully submitted,



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³Weil v. Fritz, 572 F.2d 856, 865-66 n.16, 196 USPQ 600, 608 n.16 (CCPA 1978).